

REMARKS

Reconsideration and allowance of the subject application is respectfully requested.

Claims 1-20 have been examined. Claims 1-22 are all the claims pending in the application.

Claim rejections -- 35 U.S.C. § 103

Claims 1-16, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takeo in view of Hiyama, both of which are previously of record. Claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Takeo in view of Hiyama in further view of Cabrera.

In rejecting the claims over Takeo and Hiyama, the Examiner first cites to Takeo as teaching high and low energy data sets. However, the Examiner then presents the unsubstantiated assertion that some method of identifying images must be in place in order for the subtraction process of Takeo to work, but repeatedly acknowledges that Takeo does not teach how this information is stored or otherwise established. (see page 3 of the December 15, 2004 Office Action; page 5 of the August 25, 2005 Final Office Action). Then, stemming from this unsubstantiated assertion, the Examiner cites a file management system disclosed in Hiyama for the general proposition of adding information in the form of a group ID to an image, and argues that it would have been obvious to modify Takeo with this general teaching of Hiyama in order to produce the claimed invention.

However, Applicant respectfully submits that the Examiner provides no support in the prior art for these assertions. New to the present Office Action, the Examiner adds that data structures for images are well known, and provides U.S. Patent No. 5,278,954 to Hohfield as

support for this assertion. However, Applicant respectfully notes that the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a prima facie case of obviousness. Moreover, the fact that references can be combined is also insufficient to establish a prima facie case of obviousness. See MPEP § 2143.01, at III and IV.

In the instant case, Applicant submits that Takeo does not address identification of images at all, nor does Takeo even suggest that identification of images is a problem to be addressed. The Examiner speculates, without support from the prior art, that there must be some way to identify images. Based on this first unsubstantiated speculation, the Examiner jumps to a second unsubstantiated assertion -- i.e., the need for a data structure. Then, the Examiner jumps to the teachings of Hiyama.

However, these two speculations -- that a way to identify images is required and that hence there is a need for a data structure of some sort -- are unsubstantiated in the prior art. Applicant notes specifically that the correlation can be done by an operator rather than a data structure. Thus, without some support in the prior art for these assertions, Applicant respectfully submits that the Examiner has not established a prima facie case of obviousness.

The laser-based matching causes difficulty in matching of images, which is what the present invention is designed to eliminate. Takeo, at best, represents a technique (i.e., user-based identification and correlation) that Applicant attempts to obviate by the invention.

It is thus clear that without the disclosure in Applicant's specification, the Examiner would not have made either of these jumps. Applicant respectfully submits that the Examiner's motivation to combine the teachings of Takeo and Hiyama is improper for these reasons.

Moreover, assuming *arguendo* that the teachings of the Takeo and Hiyama references may be combined, the combination still does not teach all of the features of the claimed invention. For example, claim 1 recites adding combination information to both the low and high energy image data sets that "identifies in each data set at least one other image data set". The Examiner acknowledges that Takeo does not teach this feature, but cites Hiyama as allegedly curing the deficiency. As best understood by Applicant, the Examiner's position is that one of more of the IDs of Hiyama teach this feature. See, e.g., Hiyama, FIG. 2, #71, 72, 73. However, these IDs are external to the image data sets, and thus do not "identify another image data set", as set forth by claim 1. Applicant respectfully submits that claim 1 is patentable for this reason.

Independent claims 3, 4, and 12 recite similar features and therefore are patentable for the same reasons. The remaining claims are patentable based on their dependencies.

Claims 17 and 18 each depend from independent claim 1, which has been shown above to be patentable of Takeo and Hiyama. Cabrera does not cure the deficiencies of Takeo and Hiyama. Accordingly, Applicant respectfully submits that claims 17 and 18 are patentable for this reason.

New claims

Applicant herein adds new claims 21 and 22 in order to claim additional features of the invention, and respectfully submits that they are patentable based on their respective dependencies.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


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